

Notice of Allowability

Application No.

09/931,285

Examiner

Frank W Lu

Applicant(s)

STUELPNAGEL ET AL.

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/28/2004.
2. ☒ The allowed claim(s) is/are 1 and 3-37.
3. ☒ The drawings filed on 13 March 2002 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 10/26/2004.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

Reasons for Allowance

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. David Gay (Reg. No. 39, 200) on October 26, 2004.

2. The application has been amended as follows:

Replace "flanking a first target sequence" in step b) of claim 12 with --- comprising a first target sequence---.

Replace "flanking a second target sequence" in step f) of claim 12 with --- comprising a second target sequence---.

Replace "flanking a first target sequence" in step d) of claim 12 with --- comprising a first target sequence---.

Replace "flanking a second target sequence" in step g) of claim 12 with --- comprising a second target sequence---.

3. The following is an examiner's statement of reasons for allowance:

Claims 1 and 3-37 are allowable in light of the applicant's amendments filed on September 28, 2004 and the examiner's amendments. The closest prior art in the record are Khanna *et al.*, (Oncogene, 18, 27-38, 1999), Monforte *et al.*, (US Patent No. 5,830,655, published on November 3, 1998), Zhang *et al.*, (US Patent No. 5,876,924, published on March 2,

Art Unit: 1634

1999), Uematsu *et al.*, (US Patent No. 6,225,064 B1, filed on October 7, 1999), Chee *et al.*, (US Patent No. 6,355,431 B1, filed on March 2000, priority date: April 20, 1999), and Barany *et al.*, (US Patent No. 6,027,889, filed on May 28, 1997, priority date: May 29, 1996). The reference of Khanna *et al.*, does not teach performing a first analysis of said at least 10 different target nucleic acids and performing a second analysis of said at least 10 different target nucleic acids recited in claim 1 filed on September 28, 2004. The combination of Khanna *et al.*, with other references in the record can not be used to reject claims 12-18 and 21-37 since Khanna *et al.*, do not teach steps f) and g) of claim 12, step c) of claim 16, and analysis of at least 10-100 different target nucleic acids in a single reaction recited in claims 21-23. These prior art either alone or in combination with the other art in the record does not teach or reasonably suggest methods which comprise all of the limitations recited in claims 1, 12, and 16.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703) 872-9306.

Art Unit: 1634

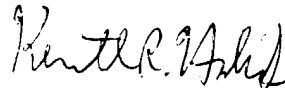
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746.

The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (571)272-0746.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

Frank Lu
PSA
October 26, 2004


KENNETH R. HORLICK, PH.D.
PRIMARY EXAMINER
10/28/04